

UnitedP\_P\_1\_04  
Examiner Janell Combs Morillo

10/807,719  
Art Unit 1742

### **CLAIM HISTORY**

**Claim 1** is presently pending.

**Claim 1** is rejected.

### **Listing of Claims**

1. (original) A manganese sterling silver alloy composition exhibiting the desired properties of improved hardness and reversible heat treatability, in addition to reduced fire scale formation, reduced porosity, and reduced grain size. consisting essentially of the following parts by weight: about 92.5 - 92.8% silver, about 2.0 - 3.0% copper, about 2.0 - 3.0% zinc, about 0.03 - 0.05% indium, about 0.01 - 0.03% tin, about 0.20 - 0.50% boron/copper alloy (21.0% boron, 98.0% copper) about 0.50 - 0.90% silicon/copper alloy (10.0% silicon, 90.0% copper), and 0.01% - 0.10% manganese.

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**35 U.S.C. 103 in combination with 35 U.S.C. 102(e) removes primary reference.**

35 U.S.C. 103 Conditions of patentability; non-obvious subject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

**MPEP 2146 Re: 35 U.S.C. 103(c)**

Effective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as "prior art" only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. 35 U.S.C. 103(c) applies only to subject matter which qualifies as prior art under 35 U.S.C. 103; it does not affect subject matter which qualifies as prior art under 35 U.S.C. 102, i.e., anticipatory prior art. See MPEP § 706.02(I) - § 706.02(I)(3).

**1) The subject matter and the claimed invention were commonly owned at the time the invention was made.**

The invention disclosed in Bernard (US 5,039,479) was made by another and is assigned to United Precious Metal Refining, Inc., 2781 Townline Road, Alden, NY 14004. Applicant's invention, at the time it was made was owned by United Precious Metal Refining, Inc., as was recorded as an assignment at the time of filing.

**2) The invention disclosed by Bernard is subject matter that qualifies only as 35 U.S.C. 102(e) "prior art".**

The invention disclosed by Bernard is subject matter that qualifies only as 35 U.S.C. 102(e) "prior art". The invention disclosed by Bernard is subject matter that does not qualify as anticipatory 35 U.S.C. 102 prior art. This is shown by the fact that the Examiner uses the reference only as a primary reference in a 35 U.S.C. 103 rejection. Moreover, Bernard does not teach all of the limitations recited in Applicant's claim.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Moreover, the use of manganese is neither expressly or inherently described by Bernhard, therefore Bernhard is not anticipatory.